

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Art Unit: 1644
CLASSEN, John Barthelow) Examiner: GAMBEL, P.
Serial No.: 08/591,651) Washington, D.C.
Filed: February 12, 1996) February 4, 2013
For: METHOD AND COMPOSITION) Docket No.: CLASSEN-1A
FOR AN EARLY VACCINE TO)
PROTECT AGAINST BOTH...) Confirmation No.: 9417

INFORMATION DISCLOSURE STATEMENT [IDS] NO. 8

U.S. Patent and Trademark Office
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Alexandria, VA 22314

S i r :

This Information Disclosure Statement is submitted in accordance with 37 C.F.R. 1.97, 1.98, and it is requested that the information set forth in this statement and in the listed documents be considered during the pendency of the above-identified application, and any other application relying on the filing date of the above-identified application or cross-referencing it as a related application.

1. This IDS should be considered, in accordance with 37 C.F.R. 1.97, as it is filed:

[] A. within three months of the filing date of the above-identified national application or within three months of the entry into the national stage of the above-identified international application. See 37 CFR 1.97(b)(1) and (3).

[] B. before the mailing date of a first office action on the merits. See 37 CFR 1.97(b).

[X] C. after (A) and (B) above, but before final rejection or allowance, and Applicants have made the necessary certification (box "i" below) or paid the necessary fee (box "ii" below). See 37 CFR 1.97(c)(2).

[] i. Counsel certifies that, upon information and

belief, each item of information listed herein was either (a) cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS or (b) was not cited in a communication from a foreign patent office in a counterpart foreign application and was not known to any individual designated in 1.56(c) more than three months prior to the filing of this IDS.

[X] ii. A Credit Card Authorization, authorizing payment for the fee set forth in 1.17(p), presently believed to be \$180, is attached.

[] D. after (A), (B) and (C) above, but on or before payment of the issue fee. The statement required by 37 C.F.R. 1.97(d) for consideration of this IDS follows. Counsel certifies that, upon information and belief, each item of information listed herein was either (i) cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS or (ii) was not cited in a communication from a foreign patent office in a counterpart foreign application and was not known to any individual designated in 1.56(c) more than three months prior to the filing of this IDS. A Credit Card Authorization, authorizing payment for the fee set forth in 1.17(p)(1), presently believed to be \$180 is attached.

[] E. As a submission in accordance with the transitional procedure for limited examination after final rejection pursuant to 37 CFR §1.129(a). Pursuant to MPEP §706.07(g), page 700-66, col. 2 (August 2001), this IDS is treated as if filed with a period set forth in 37 CFR §1.97(b) and considered without the petition and petition fee required by 1.97(d).

[] F. As a submission with or after a request for continued examination under CFR §1.114, and before the mailing

of a first office action on the merits on the RCE. See 37 CFR §1.97(b) (4) and MPEP 609.04(b), stage (1)(c).

2. In accordance with 37 C.F.R. 1.98, this IDS includes a list (e.g., form PTO-1449) of all patents, publications, or other information submitted for consideration by the office, either incorporated into this IDS or as an attachment hereto. A copy of each document is attached, except as explained below.

[] While an IDS filed under §1.97 must contain a "list of all patents, publications or other information submitted for consideration by the Office", see §1.98(a) (1), the only requirement for the list is that it provide the information set forth in §1.98(b). There is no requirement that a form PTO-1449 be used (MPEP §609 merely says that use of this form is "encouraged"). Counsel has used a list provided to him by Applicants, and not transferred the information to a PTO-1449, to avoid the risk of any inadvertent error in transferring the information.

[X] A1. Documents LA-LD are U.S. Patents or U.S. Patent Publications, and hence copies of these documents have not been provided. See 37 CFR 1.98(a)(2)(ii).

[X] A2. Documents LE-LI are pending U.S. applications whose specifications and drawings appear in the IFW, and hence copies of these documents have not been provided. See "Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications" (Oct. 19, 2004),
<http://www.uspto.gov/web/offices/com/sol/og/2004/week42/patwaiv.htm>

[X] A3. Documents LA-LD are copending, commonly owned U.S. patent applications, or U.S. patents and are provided so the examiner may evaluate whether they raise double patenting, 102(e), interference or other issues.

Providing these documents is not to be construed as an admission that these applications present claims that conflict with, or are substantially similar to, the instant

claims, or that they in fact raise such issues.

4. No explanation of relevance is necessary for documents in the English language (see reply to Comments 67 and 68 in the preamble to the final rules; 1135 OG 13 at 20).

5. If the month of publication of a nonpatent reference is not stated, it is because it is not apparent from review of the reference. If requested to do so by the Examiner, Applicants will attempt to locate and write to the publisher.

If the publication date of a cited document is set forth only as a publication year, and that year is prior to the year of filing or, if priority is claimed, year of priority of this application, then the particular month of publication is not in issue. Likewise if that publication year is after the year of filing of this application, the month of publication is not in issue.

If the date of publication of a nonpatent reference is stated, then, except as explained below, it is the nominal date stated in the reference, or in a larger document (journal or book) from which the reference was extracted. Applicants reserve the right to challenge this date by contacting the publisher to determine the actual shipment date, or by contacting recipients to determine the receipt dates.

6. Other information being provided for the examiner's consideration follows:

patent reference LA, the nonpatent references LJ-LS cited herein, were cited in one or more of the three inter partes reexaminations cited herein as LE-LG. LE-LG are reexaminations of the patents LB-LD.

A courtesy copy of the July 23, 1997 IDS including all lists is attached hereto.

The IFW copy of this submission is incomplete. It includes only the 4 page introductory document and the pages with references numbered 1-37, the latter subsequently initialed as considered. However, the IDS additionally included (1) a page listing references AL (EP 94,575) and AM (WO 92/03733), which were cited in the International Search Report and consequently copies should have been transmitted to the US/RO by the ISA/EP and considered per MPEP 609.03, (2) a copy of a June 20, 1996 PTO-892 in the parent case, listing references A-D, R, and S, (3) a copy of a February 2, 1994 PTO-892 in the parent case, listing references A-C, and (4) a copy of a 4 page PTO-1449 in the parent case, listing references AA, AB and AL-CN. Copies of the references for items (2) - (4) were to be found in the parent case. Even if the lists for (2) - (4) had not been submitted, the references from the parent case should have been considered per MPEP 609.02.

We note that the PTO rules at the time of submission of this IDS did not require that the serial number of the new case be placed on this sheet. However, this serial number has now been added.

We also note that our file copy of the October 23, 1998 office action included an unmarked copy of item (4) above, i.e., the PTO plainly received item (4).

7. In accordance with 37 C.F.R. 1.97(g) and (h), the

filling of this IDS should not be construed as a representation that a search has been made or that information cited is, or is considered to be, material to patentability as defined in §1.56 (b), or that any cited document listed or attached is (or constitutes) prior art. Unless otherwise indicated, the date of publication indicated for an item is taken from the face of the item and Applicant reserves the right to prove that the date of publication is in fact different.

8. The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this paper or credit any overpayment to Deposit Account No. 02-4035.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By: _____


Iver P. Cooper
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Enclosures

-IDS list for new references LA-LR (2 pp.)
-courtesy copy of IDS (4 pp) and IDS list (10 pp) filed
February 23, 1997.

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